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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,777	03/03/2004	Hiroyuki Tanaka	118910	3205
25944	7590	06/21/2006	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,777

Applicant(s)

TANAKA ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 20 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-6 and 20 in the reply filed on 6 June 2006 is acknowledged. The traversal is on the ground(s) that the claims of Groups I, II and III are drawn to sufficiently inter-related inventions to warrant examination thereof in a single application. Applicants note that Group I is drawn to a toner for electrophotography, Group II is drawn to an image-forming method using a toner for electrophotography, and Group III is drawn to an image-forming apparatus in which a means for developing an electrostatic latent image uses a toner for electrophotography. Applicants also note that Groups I and II are subject to rejoinder when the elected invention is found allowable and that no burden of search exists for the separate groups. This is not found persuasive because the search required for each group is not require of the other groups. For example, the search for the toner of Group I requires no search of the image forming method of Group II or the apparatuses of Group III. The search for the method of Group II requires, at most, a minimal search of the toner because the toner must be used in the claimed method to address the limitations of the claims. With respect to Group III, the apparatus is not limited by the toner for the reasons given in the last Office action. Further art relevant to the toner would not be required to show any apparatus limitations. The inventions are not sufficiently inter-related to permit search and examination in a single application. Although rejoinder would be permitted if the toner is found to be allowable, the rejoinder process only becomes active when the product (i.e., the toner) is found allowable. This is not the situation because the toner is not allowable for the reasons given below. Further the rejoinder process does not negate a valid restriction process because rejoinder is only effective when a restriction is made and the product is allowable

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Emura *et al.* in US Patent Application Publication 2003/0008225 considered with Igarashi *et al.* in US Patent 5,597,386.

Emura discloses in Example 1 a toner for electrophotography containing 100 parts of a polyester resin, 6 parts of carbon black MA-100, a product of Mitsubishi Chemical Corporation, and 3 parts of a polypropylene wax release agent. The toner has an average particle diameter of 10 μm (¶ [0176]). As seen in the supporting disclosure from Igarashi, the commercially available carbon black has a size of 22 nm (col. 15, l. 26-28). Figure 1 in Emura shows the storage modulus of Example 1's toner. At a temperature of 180 °C the toner has a storage modulus of about 8×10^2 Pa. In this example the carbon black meets the requirement of both the coloring agent and inorganic particles with a diameter of from 5 to 200 nm. This coloring agent is present in an amount of 5.5 % by mass. The polypropylene wax is a synthetic hydrocarbon wax. This class of wax is taught as effective in the instant specification (p. 8, l. 15). An advantage of this toner composition is its offset resistance and wax dispersibility (Abstract; Table 4).

Because the reference toner contains each of the requisite materials in the requisite amounts, exemplifies storage modulus claimed, and has reduced adherence to developing

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rollers as shown by reduced offset, it appears that Emura's toner would inherently have the adhesive force to aluminum specified in the instant claims.

Claim Rejections - 35 USC § 103

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Emura *et al.* in US Patent Application Publication 2003/0008225 in view of *Handbook of Imaging Materials*, 2nd ed., to Diamond *et al.*, pp. 145-164.

Emura was discussed above. The reference does not disclose the presence of the toner in a toner cartridge having the means claimed. However, the toner is used for the production of images (¶ [0116] & Examples).

Diamond shows the conventional devices used to produce images using toner. These include a process cartridge (see Fig. 4.10). This toner cartridge also contains a development device, as seen in the Figure of the text.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the toner of Emura in a toner cartridge having a means for developing because this cartridge is well known in the art for the production of images, such as in LaserJet printers, and the artisan would use the toner in a device that gives images quickly and easily for both home and office settings.

Allowable Subject Matter

Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cdr
19 June 2006



CHRISTOPHER RODEE
PRIMARY EXAMINER